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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,011	02/23/2004	R. Lee Miller	21154.022	7482

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/783,011

Applicant(s)

MILLER, R. LEE

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The change to the specification is agreed with and the objection to the disclosure is removed.

Claim Rejections - 35 USC § 112

2. The changes to claims 2 and 7 are agreed with and the rejection under 35 U.S.C. 112, second paragraph, is removed.

Response to Amendment

3. The amendment filed 7 April 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In claims 9 and 14, the cap end sufficiently outwardly flared or stepped was not in the disclosure as originally filed and as such is considered new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over 2001-46568 in view of Miyasu.

2001-46568 lacks a grip having an external surface substantially circular cross-sectional configuration through out the length of a body, an alignment means extending upwardly from an exterior surface of a body from a shaft end to a cap end and an alignment means being an elongated ridge in alignment with a longitudinal axis of a body. Miyasu (Figs. 1, 4, Abstract, [0015]) discloses an alignment means extending upwardly from an exterior surface of a body from a shaft end to a cap end, an alignment means being an elongated ridge in alignment with a longitudinal axis of a body and an external surface being circular. Miyasu does not disclose the external surface being circular throughout the length of a shaft but clearly an artisan designing a grip with a uniform feel would have selected a suitable shape throughout the length in which circular is included. In view of the patents of Miyasu it would have been obvious to modify the grip of 2001-46568 to have an alignment means extending upwardly from an exterior surface of a body from a shaft end to a cap end and an alignment means being an elongated ridge in alignment with a longitudinal axis of a body in order to assist a

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golfer in properly aligning a club at impact. In view of the patents of Miyasu it would have been obvious to modify the grip of 2001-46568 to have a grip having an external surface substantially circular cross-sectional configuration through out the length of a body in order to provide a uniform feel along the length of a shaft by having the shape stay the same.

6. Claims 2-3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over 2001-46568 in view of Miyasu as applied to claims 1, 4-6 and 8 above, and further in view of Hadge.

2001-46568 lacks a grip having a diameter at a shaft end being .92 to .95 inch and a diameter at a cap end being .77-.80 inch. Hadge discloses a reversed tapered grip having a grip having a diameter at a shaft end being .92 to .95 inch and a diameter at a cap end being .77-.80 inch (Col. 3, Lns. 54-59). In view of the patent of Hadge it would have been obvious to modify the grip of 2001-46568 to have a diameter at a shaft end being .92 to .95 inch and a diameter at a cap end being .77-.80 inch. in order to utilize dimensions for reverse tapered grips used in the market place.

7. Claims 9, 12-14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over 2001-46568 in view of Miyasu and Jacques.

2001-46568 lacks a cap end sufficiently outwardly flared. Jacques discloses reverse taper grip having a cap end sufficiently outwardly flared in order to prevent a club from sliding endwise out of the hands should a golfer relax his grip (Col. 2, Lns. 43-

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48). In view of the patent of Jacques it would have been obvious to modify the grip of 2001-46568 to have a cap end sufficiently outwardly flared in order to prevent a club from sliding endwise out of the hands should a golfer relax his grip.

8. Claims 10-11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over 2001-46568 in view of Miyasu and Jacques as applied to claims 9, 12-14, and 16 above, and further in view of Hadge.

See paragraphs above for elements of structure previously rejected by 2001-46568 in view of Hadge.

Response to Arguments

9. The argument that the combination of 2001-46568 and Miyasu are improper due to both not conforming to the USGA Rules of golf is disagreed with. Patents are given to inventions irrespective if they meet rules of some type of athletic governing organization. There are many new inventions in golf that are novel and are given patents though they do not meet the USGA rules of golf and they are being used on golf courses. The argument that the references of 2001-46568 and Miyasu are improper due to not having an external surface of substantially circular cross-section throughout the length of a body is disagreed with. Miyasu clearly shows a circular cross-section. Miyasu is quiet with respect to the rest of the lengths cross section however clearly since nothing states that it changes in shape and since substantially circular cross

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sections along the length is the most common shape, this would be an obvious selection to one skilled in the art. The argument that 2001-46568 is improper due to it being designed to enhance comfort and the invention was designed to enhance performance is disagreed with. In the English Abstract and Solution of 2001-46568 it states that this grip is to stabilize gripping of a club to improve swing stability. This reference not only meets the claimed taper but the function of an improved grip for the user's hand and better control of the golf club. The argument that it is improper to combine the references of 2001-46568 and Miyasu because 2001-46568 teaches reverse taper for swing stability and Miyasu teaches ridges preventing a club from slipping out of one's hands and the invention teaches a reverse taper for improve control and a ridge for consistent placement is disagreed with. Combining prior art is not based on the motivations for why an applicant used to produce structure elements. It is based solely on if it would be obvious to one skilled in the art which the examiner believes. None-the-less Miyasu also teaches a ridge to facilitate alignment (Abstract). Clearly a ridge to facilitate alignment and rotational slippage would benefit any type of tapered grip. The argument that the combination of 2001-46568 and Miyasu is improper due to empirical data disclosed during testing shows the invention has solved a long felt and long standing problem in the field of golf is disagreed with. 2001-46568 discloses a reverse tapered grip with all different types of tapered shapes and nothing was stated that it was tested also. There is nothing which proves the invention has a performance any better than the grip of 2001-46568. The argument that combination of 2001-46568 and Miyasu is improper due to all the recognition from Golfweek Magazine,

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"The Wire" articles, Golf Illustrated article, and Pub Links article is disagreed with.

2001-46568 shows the same taper profile as claimed in the independent claims, many different magnitude of tapers (Figs. 5-6) and the improve swing stability. It is uncertain what other grips they evaluated and if they made their statements without seeing the grip of 2001-46568. The argument that it is improper to use the references due to the large number of references used to reject the claims is disagreed with. What matters is if would be obvious to combine the teachings in each of the references which the examiner believes. In addition the examiner does not believe it would take an awkward step for one skilled in the art to combine the steps. For example would it be obvious to put a ridge for alignment of the hands as taught by Miyasu with a reverse taper grip of 2001-46568? The examiner believes that is a simple answer of yes since all players have to align hands on all grips.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Blau whose telephone number is (571) 272-4406. The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 15 May 2005


STEPHEN BLAU
PRIMARY EXAMINER